

REMARKS

The undersigned thanks the Examiner for the telephone interview of June 2, 2003. Prior to the interview of June 2, 2003, the undersigned called the Examiner to find out which example of Ichikawa the Examiner considers as being the closest prior art example for the inventors to test to show lack of inherency. The Examiner said that she would check Ichikawa and discuss this matter with the Supervisor and call the undersigned. The Examiner then called the undersigned on June 2, 2003.

During the interview of June 2, 2003, the Examiner said that she reviewed Examples 5-14 and 24-26 of Ichikawa and discussed them with the Supervisor. However, they could not decide what is the closest prior art. Thus, the Examiner said that the inventors should select a prior art sample that includes the ingredients on which elements in the claim would read but there should not be too many extra ingredients otherwise the example tested would not be commensurate with the scope of the claim.

In the attached Nagase Declaration, Mr. Nagase first explains that the closest prior art sample of Ichikawa is that of Example 7 and the next closest prior sample of Ichikawa is that of Example 24. Subsequently, Mr. Nagase shows that closest prior art samples of Ichikawa, namely samples of Examples 7 and 24, do not possess the properties recited in the independent pending claims, namely, the limitations:

an ultraviolet absorption spectrum of said directly imageable planographic printing plate precursor, observed by the transmission method, has the following features:

(1) the main peak in the ultraviolet absorption spectrum exists between 700 nm and 1,200 nm, and

(2) the ratio A/B of the absorbance at 830 nm (A) to the absorbance at 650 nm (B) is not less than 3.0.

Claims 1-17 were rejected as being anticipated by Ichikawa. This rejection is respectfully traversed and should be withdrawn in light of Mr. Nagase's Declaration. "To serve

as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so *recognized* by persons of ordinary skill.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). The “ratio A/B of the absorbance at 830 nm (A) to the absorbance at 650 nm (B) is not less than 3.0” recited in the independent claims is not even present in the closest prior art samples, i.e., Examples 7 and 24 of Ichikawa. Thus, Applicants respectfully submit that this missing descriptive matter is *not* necessarily present in Ichikawa.

In the event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 360842007600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: July 28, 2003

Respectfully submitted,

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